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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,869	02/08/2001	Steven M. Horowitz	14531.79	6689

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EXAMINER

LAMBRECHT, CHRISTOPHER M

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,869

Applicant(s)

HOROWITZ, ET AL.

Examiner

Christopher M. Lambrecht

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,10,12-15,17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,10,12-15,17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 10, 12-15, 17, and 19-21 rejected under 35 U.S.C. 102(e) as being anticipated by Hicks, III et al. U.S. Patent Application Publication No. 2004/0261112 ("Hicks").

Regarding claims 1, 10, and 17, Hicks discloses an apparatus (fig.1, item 100) and corresponding method (fig.4) in a system having a set-top box (fig.1, items 300) receiving digital programming content comprised of multiple channels ([0038]), and wherein the programming content of each channel is provided to the set-top box ([0042]) in an encoded digital format determined by the provider of the content ([0039]), the apparatus for recording one or more selected channels without decoding them prior to recording ([0040]) so as to store them in the same encoded digital format as determined by the content provider in order not to degrade the recording quality of the selected channels, the apparatus comprising:

- tuner and a demodulator (fig.2, item 120) adapted for receiving and operating on the digital programming content to identify multiple channels contained by the programming content ([0038]), and wherein the content of each channel is encoded in a digital format that is determined by a content provider and wherein the digital format of at least one channel is other than MPEG ([0047]-[0048], discussing digital media encryption formats);
- a transport (fig.2, item 105) coupled to the output of the demodulator and adapted to demultiplex the multiple channels of the transport stream in order to permit selection of the at least one channel, the transport being capable of selecting a channel encoded in a plurality of digital formats ([0041]); and
- a storage device coupled to the transport for recording the at least one channel without decoding it ([0040]) so as to store it using the same digital format with which the at least one channel was received at the set-top box in order to store the digital content of the at least one channel without degrading it, wherein the storage device can receive content encoded in any of the plurality of digital formats from the transport [0038], [0040]).

As to claim 12, Hicks discloses an apparatus and corresponding method as defined in claim 10, wherein the at least one channel is compressed ([0039]).

As to claims 15 and 19, Hicks discloses an apparatus as defined in claim 17 (see above), further comprising a decoder (fig.3, item 325) that is connected to the storage medium such that a previously recorded channel may be decoded and displayed on a display device while the at least one selected channel is recorded on the storage medium ([0043], [0046], [0055]).

As to claims 13, 14, and 20, Hicks discloses an apparatus and method as defined in claims 10 and 19 (see above), wherein the decoder is also coupled to the transport so that a selected channel output from the transponder may be simultaneously directed to both the storage medium for recording and to the decoder for display of the selected channel as it is recorded ([0046]).

As to claim 21, Hicks discloses an apparatus as defined in claim 17 (see above), further comprising a conditional access system for determining whether a selected channel may be displayed ([0047]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Lambrecht whose telephone number is (571) 272-7297. The examiner can normally be reached on weekdays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on weekdays at (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M. Lambrecht
Examiner
Art Unit 2623

cml


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